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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,095	03/27/2001	Debabrata Mukherjee	00-40383-US	2838

7590

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

6

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk 6

**Office Action Summary**

Application No.

09/818,095

Applicant(s)

MUKHERJEE ET AL.

Examiner

Betelhem - Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,16,18,19,28,29,31,33-43,47,48 and 52 is/are rejected.
- 7) ☒ Claim(s) 3-15,17,20-27,30,32,44-46 and 49-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims ~~2~~, ~~16~~, 19, 28, 29, 31, ~~33-43~~ and ~~52~~ are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- OK a. In claim 2, it is not clear where the one or more anticurl layers are positioned.
- OK b. In claim 16, it is not clear if the barrier layer is an outer layer? Clarification of the structure of the paper medium is kindly requested.
- OK c. Claims 19, 35 and 36 recite the limitation "water loving" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim.
- OK d. In claim 28, it is not clear which layer contains the flow agent.
- OK e. In claim 29, it is not clear which layer contains the coating additive.
- OK f. In claim 31, it is not clear which layer contains the plasticizer.
- OK g. In claim 52, it is not clear where the anticurl coating is located. Clarification of the structure is requested.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1774

4. Claims 1, ~~2~~, ~~18~~, ~~33~~, ~~34~~, ~~37~~, ~~41~~, ~~43~~, ~~47~~ and ~~48~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Stokes et al. (US 5,660,928).

Stokes discloses a coated substrate having a first layer, a second layer on one side of the first layer, a third layer on the second layer, a forth layer on the other side of the first layer, and a fifth layer between the first and the second layer (col. 2, lines 18-62). The claimed substrate is equivalent to the first layer; the claimed undercoat is equivalent to the fifth layer; the claimed barrier layer is equivalent to the second layer; the claimed ink receptive layer is equivalent to the third layer; and the claimed anticurl layer is equivalent to the forth layer. The third layer is composed of polyethylene imines (col. 4, line 11). The second layer is cured by thermal energy (col. 6, line 19), and has a coat weight of 15 gsm (col.6, line 17).

ink recep (3)  
barrier (2)  
undercoat (5)  
base (1)

#### **Allowable Subject Matter**

5. Claims ~~3, 4, 5~~ <sup>19, 28, 29, 31</sup> 17, 20-27, 30, 32, 44-46 and 49-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Stokes fails to teach all of the limitations disclosed in each of the objected claims.

#### **Miscellaneous**

6. In claims 1 and 52, the preamble of the claims is directed to a composition but the body of the claims is directed to an article. Applicant is advised to amend the preamble to make it consistent with the body of the claims, and amend the preamble of claims 2-51 in view of claim 1.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

BS *BS*  
September 18, 2002.

*Cynthia H Kelly*